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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/996,445 | 11/28/2001 | John Border | 115426-1006 | 2403 |
| 29158 7590 07/25/2007 BELL, BOYD & LLOYD LLP P.O. BOX 1135 CHICAGO, IL 60690 | | | EXAMINER STRANGE, AARON N | |
| | | | ART UNIT 2153 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/996,445

Applicant(s)

BORDER ET AL.

Examiner

Aaron Strange

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8,10-12,15,17-19,22,24-26,29,31-36 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8,10-12,15,17-19,22,24-26,29,31-36 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. As an initial matter, the Examiner apologizes for any confusion caused by the Office Action of 2/15/2007. The Examiner was aware of potential confusion arising from the Office Action and offered to conduct an interview to clarify any issues (Office action of 2/15/2007, ¶11). However, it is noted that Applicant chose not to contact the Examiner to seek clarification prior to filing a response.

The Examiner has attempted to clarify the position of the Office in this action. Once again, if Applicant wishes to seek clarification of any portion of this action, he/she is invited to contact the Examiner to schedule an interview.

Response to Arguments

2. Applicant's arguments filed 5/15/2007 have been fully considered but they are not persuasive.

3. With regard to exemplary claim 1, and Applicant's assertion that ¶41 of the present application adequately describes how to make and use the claimed invention, the Examiner respectfully disagrees.

As discussed in the Office action of 2/15/2007, the limitation "forward the object based on a predetermined criteria relating to the object, including time-to-live of the object and the object being marked as uncacheable" is not enabled by the specification. The specification states that objects that have a time to live are cacheable (¶41, Lines

9-10). Since a cacheable object would never be marked "uncacheable", there is no way to forward an object based on this criteria, since no object would ever satisfy the criteria.

Applicant argues that the claim limitation recites "two, **unrelated, examples**" (Remarks, 9). However, such an interpretation of the claim limitation is inconsistent with the plain language of the claim and the prosecution history of the present application. Claim 1 recites "forward the object based on a predetermined criteria relating to the object, including time-to-live of the object **and** the object being marked as uncacheable" (emphasis added). The plain meaning of the claim language requires the object to be forwarded based on "a criteria" including two portions, "time-to-live of the object" and "the object being marked as uncacheable".

The prosecution history of the present application also supports this interpretation. The first amendment adding a version of this limitation was presented in the response filed 4/20/2005, adding a new limitation to claim 2. That amendment read "the predetermined criteria including size of the object **or** life of the object". That language clearly reads as an alternative listing of criteria, and was treated as such by the Examiner. Criteria subsequently connected with an "and" cannot reasonably be interpreted as alternative criteria.

4. If Applicant intends for the claim to recite the criteria as alternatives, the claim should be amended to do so. For example, amending the claim to recite "forward the object based on a predetermined criteria relating to the object, including time-to-live of the object **or** the object being marked as uncacheable" would be sufficient to obviate the

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rejection presented under 35 U.S.C. § 112, and result in the limitations being interpreted as alternatives.

Claims 8, 15, 22 and 35 contain similar limitations and similar amendments made to those claims would be sufficient to overcome the remaining 35 U.S.C. § 112 rejections.

5. With regard to Applicant's argument that the limitations discussed above "are not so much alternatives as they are **examples** of criteria" (Remarks, 9), this argument is unclear. It is well established that providing examples in the claim renders the claim indefinite because it is unclear whether the examples are part of the claimed invention. See MPEP § 2173.05(d). In this case, if the claimed criteria are intended as mere examples, the claim limitation would be met by a reference teaching *any* predetermined forwarding criteria, and would not need to disclose either of the examples in the claim. This is inconsistent with the plain language of the claim and Applicant's prior arguments regarding the forwarding criteria.

6. With regard to Applicant's objection to the alleged "back-door" rejection (Remarks, 9-10), it is noted that the Examiner merely intended to put Applicant on notice that amending the claims to claim the criteria in the alternative would result in claims that would be unpatentable over the prior art of record, since the "time-to-live" criteria was previously rejected. This was noted only in a sincere effort to expedite prosecution, and was not intended to create the confusion it appears to have caused.

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To prevent a similar occurrence in the future, the Examiner will no longer refer to previous Office actions.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1,8,15,22,35 and their respective dependents are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

9. With regard to claim 1, the limitation “forward the object based on a predetermined criteria relating to the object, including time-to-live of the object and the object being marked as uncacheable” is not enabled by the specification. The specification states that objects that have a time to live are cacheable (¶41, Lines 9-10). Since a cacheable object would never be marked “uncacheable”, there is no way to forward an object based on this criteria, since no object would ever satisfy the criteria.

Based on ¶41 of the specification, it appears that these may be alternative

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criteria for forwarding, rather than complimentary criteria, but the current claim language does not capture such a relationship.

10. Claims 8,15,22 and 35 are rejected under the same rationale, since they contain a substantially identical limitation.

11. All claims not individually rejected are rejected by virtue of the dependency from the above claims.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AS



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